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PATENT TRADEMARK OFFICE

PATENT

Application Number: 09/733,900

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Carlos PINZON et al.

Application No.: 09/733,900

Filed: December 12, 2000

For: COSMETIC COMPOSITIONS  
CONTAINING HETEROPOLYMERS AND  
OIL-SOLUBLE CATIONIC SURFACTANTS  
AND METHODS OF USING SAME

Group Art Unit: 1616

Examiner: M. Lamm

14/Election  
w/traverse

Assistant Commissioner for Patents  
Washington, DC 20231

Beit  
5-9-03

Sirs:

**RESPONSE TO RESTRICTION AND ELECTION OF SPECIES  
REQUIREMENTS**

In response to the Restriction and Election of Species Requirements  
dated April 7, 2003, Applicants respectfully request reconsideration of this  
application in view of the following remarks.

**I. Status of the Claims**

Claims 1-346 are pending in this application. Applicants acknowledge  
withdrawal of the restriction and election of species requirements set forth in the  
Office Action dated March 26, 2003.

**II. Restriction Requirement**

In the Office Action, the Examiner required restriction under 35 U.S.C.  
§ 121 between the following groups of claims:

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Group I: Claims 1-212, 320, 327, 328, 331-333, 336, 339-342, 345, and 346, drawn to a composition comprising at least one liquid fatty phase which comprises at least one structuring polymer and at least one oil-soluble cationic surfactant, classified in class 516, subclass 9+;

Group II: Claims 213-319, 343, and 344, drawn to an anhydrous composition comprising at least one liquid fatty phase which comprises at least one structuring polymer and at least one oil-soluble cationic surfactant, classified in class 585, subclass 10;

Group III: Claims 321, 322, 325, 329, 330, 334, 335, 337, and 338, drawn to a cosmetic composition comprising at least one liquid fatty phase which comprises at least one structuring polymer and at least one oil-soluble cationic surfactant, methods of making and using said cosmetic compositions, classified in class 424, subclass 401+;

Group IV: Claims 323 and 324, drawn to an anhydrous deodorant comprising at least one liquid fatty phase which comprises at least one structuring polymer and at least one oil-soluble cationic surfactant, classified in class 424, subclass 65; and

Group V: Claim 326, drawn to a lipstick composition in a stick form comprising at least one continuous liquid fatty phase, at least one oil-soluble cationic surfactant, and at least one non-waxy structuring polymer, classified in class 424, subclass 6.

Applicants respectfully traverse the restriction requirement. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the invention of Group III, claims 321, 322, 325, 329, 330, 334, 335, 337, and 338.

Applicants respectfully refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs the Examiner as follows

If the search and examination of an entire application can be made without **serious burden**, the Office **must** examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, Applicants respectfully submit that the Examiner has not demonstrated that examining Groups I - V together will constitute a serious burden. Applicants respectfully submit that a search of Groups I - V would not be burdensome, as all of the claims recite, *inter alia*, a composition comprising at least one liquid fatty phase comprising at least one structuring polymer and at least one oil-soluble cationic surfactant. Thus, the search and examination of Group III should substantially, if not completely, overlap the necessary search and examination for Groups I, II, IV, and V.

In the Office Action, the Examiner also required election under 35 U.S.C. § 121 of one species of each of the following: (1) at least one structuring polymer; and (2) at least one oil-soluble cationic surfactant.

Applicants respectfully traverse the election of species requirements. However, to be fully responsive, Applicants elect, with traverse, the following species. In response to the Examiner's requirement for election of one species of (1) the at least one structuring polymer, Applicants elect, with traverse, Uniclear 100. Uniclear 100 is disclosed, for example, at page 12, third full paragraph. Uniclear 100 conforms to polymers of formula (I) which is disclosed, for example, at page 10. The election of Uniclear reads on claims 321, 322, 325, 329, 330, 334, 335, 337, and 338. In response to the Examiner's requirement for election of one species of (2) the at least one oil-soluble cationic surfactant, Applicants elect, with traverse, Glucquat-100 (lauryl methyl gluceth-10 hydroxypropyl dimonium chloride). This oil-soluble cationic surfactant is

disclosed, for example, at page 25, second full paragraph, and Example 2.

Glucquat-100 reads on claims 321, 322, 325, 329, 330, 334, 335, 337, and 338.

Applicants refer the Examiner to M.P.E.P. §§ 803 and 809, which set forth the criteria and guidelines for Examiners to follow in making proper requirements for election of species requirements. In the present case, the Examiner has not shown that there would be a serious burden to examine all of the claimed species. In fact, the Examiner has not shown that any burden exists at all. Accordingly, Applicants respectfully request that the full scope of the claimed invention be examined without an election requirement. If the Examiner chooses to maintain the election requirement, however, Applicants expect, pursuant to M.P.E.P. § 809 and 37 C.F.R. § 1.141, that other species will be considered once the elected species are found patentable.

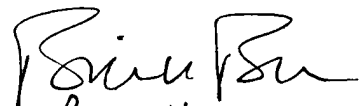
In view of the foregoing remarks, Applicants believe the election requirements to be in error, and respectfully request that the requirements be withdrawn.

If there is any additional fee due in connection with the filing of this Response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
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Dated: May 7, 2003

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